



Paper No. 25

JOHN B. FENN
4909 CARY STREET ROAD
RICHMOND, VIRGINIA 23226

COPY MAILED

APR 18 1996

In re Application of
JOHN B. FENN ET AL
Application No. 07/911,405
Filed: July 10, 1992

: OFFICE OF PETITIONS
: A/C PATENTS
: ON PETITION
:

This is a decision on the petition filed January 25, 1996, which is being treated as a petition to withdraw the holding of abandonment and as a petition under 37 CFR 1.137(a) to revive the instant application.

The petition to withdraw the holding of abandonment as to the issue fee is granted, but is dismissed as to petitioner's failure to timely submit corrected formal drawings.

The petition under 37 CFR 1.137(a) is also dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition to Withdraw the Holding of Abandonment and/or under 37 CFR 1.137(a)."

This application was held abandoned for failure to timely pay the issue fee on or before October 10, 1995.

Petitioner states that payment for the issue fee was mailed on October 10, 1995. In support of this statement, petitioner has submitted a copy of the previously mailed correspondence, which bears a certificate of mailing date of October 10, 1995, which would have rendered the response timely. Petitioner states that, upon information from the Office of Petitions, he learned that the application went abandoned for failure to pay the full amount of the issue fee. However, petitioner states that because he had

every reason to believe that the amount shown on the Notice of Allowability (Allowance) was the amount due, the delay in timely paying the full amount of the issue fee was unavoidable.

The correspondence shown to have been mailed via certificate of mailing on October 10, 1995 has been located. The \$605 fee submitted was applied towards an unintentional petition fee rather than towards the issue fee, since the correspondence fails to state the purpose of the fee. However, the fact that the full amount of the fee was not paid would not cause the application to become abandoned since, as stated by petitioner, the amount noted on the Notice of Allowance was the amount paid. The practice of the Patent and Trademark Office, after a fee increase such as the one on October 1, 1995, is to send out notices setting a period within which to submit the balance due. The instant application was held abandoned because the fee submitted was applied towards an unintentional petition fee and because the papers bearing the certificate of mailing did not come to the attention of the appropriate personnel in Publishing Division. Nevertheless, since the papers mailed via certificate of mailing on October 10, 1995 and received in the Patent and Trademark Office on October 11, 1995 have now been located, and since the certificate of mailing date renders the issue fee timely, the holding of abandonment as to petitioner's failure to timely pay the issue fee is improper.

However, this application is abandoned for failure to timely submit corrected formal drawings on or before October 10, 1995 as required by the Notice of Allowability mailed July 10, 1995. Accordingly, the date of abandonment of this application is October 11, 1995.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by (1) a proposed response to continue prosecution of the abandoned application, or filing of a continuation application, unless either has been previously filed; (2) the petition fee required by 37 CFR 1.17(1); (3) an adequate verified showing of the cause of unavoidable delay; and (4) a terminal disclaimer and fee (if a grantable petition to revive was not filed within 6 months from the date of abandonment). This petition lacks items (1), (3) and (4) above.

Petitioner has not submitted corrected formal drawings to date. Therefore, petitioner has not satisfied item (1) above.

Turning next to item (3) above, the showing is insufficient to establish unavoidable delay within the meaning of 35 USC 133 and 37 CFR 1.137(a). In this regard, the petition fails to address why corrected formal drawings as required by the Notice of Allowability mailed July 10, 1995 were not submitted and why this failure was unavoidable. Accordingly, petitioner must provide a showing as to why the failure to timely submit corrected formal drawings was unavoidable.

It is noted that, in the communication received October 11, 1995, applicant states that understood from the examiner that the drawings, which are identical with those of an issued patent, can be transferred upon request. However, this is not correct since drawings in a patented file cannot be transferred to a pending application. It is noted that this application is a 37 CFR 1.60 continuation application of the issued patent. MPEP 201.06(a) states that, when the application is allowed, applicant will be required to submit new formal drawings or to request transfer of the formal drawings from the abandoned parent application. Since the parent application was not abandoned, it would be improper to transfer the drawings. Further, it appears from the Notice of Allowability that additional changes were required to the drawings. Therefore, it does not appear that both the instant application and the parent patented file have identical drawings.

Petitioner is reminded that a petition to revive an application under 37 CFR 1.137(a) cannot be granted where a petitioner has failed to meet his burden of establishing unavoidable delay within the meaning of 37 CFR 1.137(a) and 35 USC 133. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987). Under the circumstances, petitioner has not carried his burden of proof to show that the delay was unavoidable as required by statute and by regulations of the Patent and Trademark Office.

Turning lastly to item (4) noted above, since a grantable petition has not been filed within 6 months after the date of abandonment, a disclaimer of a terminal portion of any patent which may issue on the above-identified application or on any application entitled to the benefit of the filing date of this application under 35 USC 120 is required. The period to be disclaimed will be a terminal part of the patent to be granted equivalent to the period of abandonment. The period of abandonment will be computed to be the number of months lapsed from the date of abandonment to the date of filing a grantable petition. A terminal disclaimer fee of \$55 is required. If the terminal disclaimer is signed by an assignee, the assignee must comply with the requirements of 37 CFR 3.73(b). Note attachments.

If petitioner cannot provide a showing of unavoidable delay or does not wish to and does not wish to file a terminal disclaimer, petitioner should consider filing a petition stating that the delay was unintentional. Public Law 97-247, which revised patent and trademark fees, provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable." Rules implementing these provisions have been promulgated; 37 CFR 1.137(b), 1.155(c), 1.316(c) and 1.317(c). In order to qualify, a petition must be filed within 1 year of the date of abandonment of the application or within 3 months of a first decision on a petition based on "unavoidable" delay which was filed within one year of the date of abandonment. An "unintentional" petition must be accompanied by the \$625 petition fee required by law.

Since this decision represents such a "first decision" on petition based on a showing of "unavoidable" delay, YOU HAVE THREE (3) MONTHS FROM THE DATE OF THIS DECISION OR ONE (1) YEAR FROM THE DATE OF ABANDONMENT, WHICHEVER IS LONGER, IN WHICH TO FILE AN "UNINTENTIONAL" PETITION or your right to do so will be lost.

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

A blank unintentional petition form is enclosed for petitioner's convenience.

Petitioner is advised that the filing of a terminal disclaimer is unnecessary as a condition for revival under the current provisions of 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By HAND: One Crystal Park, Suite 520
2011 Crystal Drive
Arlington, Virginia

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-8680.



Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

ATTACHMENTS: Copy of 37 CFR 3.73(b)
Certificate under 37 CFR 3.73(b)
Terminal Disclaimer Form
Unavoidable Petition Form
Unintentional Petition Form